

REMARKS

Claim 8 has been cancelled. Claims 1 through 7 and 9 through 15 remain pending in the present application. Claims 1, 2, 3, 7 and 14 have been amended. Basis for the amendments can be found throughout the specification, drawings and claims as originally filed.

Objections to the Drawings

The Examiner has objected to the drawings for various reasons. Claim 3 has been amended. Claim 8 has been cancelled. Accordingly, Applicants believe that the Examiner's objection to the drawings are now moot.

Objection to the Claims

The Examiner had objected to the claims for various grammatical errors. Claims 1, 2, 3, 7 and 14 have been amended to overcome the Examiner's objections. Accordingly, Applicants respectfully request the Examiner to withdraw his objections.

Rejection Under 35 U.S.C. §102(b)

The Examiner has rejected Claims 1 through 5 and 8 under 35 U.S.C. §102(e) as being anticipated by DeLuca.

Claim 1 defines a gripping portion for a power tool. The power tool has a housing and a motor within the housing. The gripping portion has at least one flexible member and at least one clamping member. The clamping member clamps the at least flexible member to the housing such that a gaseous vibration dampening medium is retained between the flexible member and the housing such that the flexible member protrudes through the at least one aperture.

The art relied on by the Examiner, specifically DeLuca, fails to disclose or suggest a power tool. The DeLuca reference, cited by the Examiner, nowhere discloses nor suggests its application with a power tool. Accordingly, Applicants believe Claim 1 to be patentably distinguishable over the DeLuca reference.

Claim 2 has been amended. Claim 2 defines the gripping portion with at least one flexible sheet and at least one support. The support has at least one aperture enabling a portion of the at least one flexible sheet to protrude through the at least one aperture. The flexible sheet is mounted on the support. The DeLuca reference fails to disclose or suggest Applicants' invention. While DeLuca illustrates a support 230, 250, 256, however, it fails to disclose or suggest the flexible sheet mounted on the support. In all embodiments, the flexible sheet is mounted on the finger-held utensil, such as a pen or a pencil. Accordingly, Applicants believe Claim 2 to be patentably distinct over the art cited by the Examiner. Likewise, Claims 3 through 5, which depend from Claim 2, are patentably distinct over the art cited by the Examiner.

Rejection Under 35 U.S.C. §103(a)

The Examiner has rejected Claims 6, 7 and 9 through 15 as being unpatentable over Wadge in view of DeLuca. The Examiner alleges that the combination would disclose Applicants' invention.

The Wadge reference illustrates a power tool. The DeLuca reference illustrates a cushioning device for a non-powered device such as a pen, pencil or the like. There is no motivation or suggestion to combine the two references as suggested by the Examiner.

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests a desirability of the modification." In re Fritch 23 U.S.P.Q. 2d 1780 at 1783 (Fed. Cir. 1982).

Here, the Examiner alleges that DeLuca would be combined with Wadge. However, there is no suggestion in either reference of the desirability to combine the two. Nowhere does Wadge speak of needing a dampening member. Further, DeLuca fails to disclose or suggest a dampening media. Since DeLuca places his device on a pen or pencil, it is not subjected to vibration and thus one skilled in the art would not look to this reference to utilize it as a vibration damper.

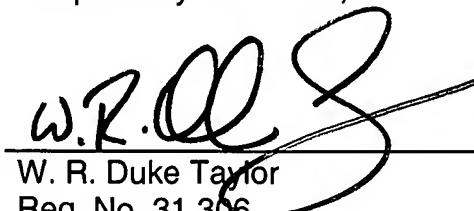
"The Examiner is relying upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fritch, supra, 1784.

Here, the Examiner has pieced together the two references to allegedly render Applicants' invention obvious. It is clear that the Examiner cannot use hindsight reconstruction to pick and choose isolated elements in the prior art to deprecate the claimed invention. There is no motivation or suggestion in either the Wadge or DeLuca references to suggest the combination of the two. Only through the Examiner's hindsight reconstruction, after having access to the claimed invention, does the Examiner combine the two references. There is no suggestion to combine DeLuca with any type of power tool as claimed. Accordingly, neither reference discloses or suggests Applicants' invention.

Accordingly, Applicants believe Claims 6, 7 and 9 through 15 to be patentably distinguishable over the art cited by the Examiner. Thus, Applicants respectfully

request the Examiner to pass the case to issue at his earliest possible convenience. Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted,

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